

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed September 19, 2008. At the time of the Office Action, Claims 14-31 were pending in this Application. Claims 14-31 were rejected. Claims 14, 28, and 29 have been amended to further define various features of Applicants' invention. Claims 1-13 have been cancelled without prejudice or disclaimer. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 14-15, 19-21, 23, 25 and 28-29 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0057663 by Byung Keun Lim ("Lim"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that the cited art as anticipated by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

Applicant submits a new set of claims replacing, without prejudice, the current set of claims. The independent claim 1 now clarifies that the method comprises announcing a form of the user data messages by transmission of at least one message comprising planning information **before transmission of the user data messages**, wherein the planning information comprises the form of the user data messages and the form of the user data messages to be transmitted includes at least one of **a data type of the user data messages** and **a coding of the user data messages**. Hereby a limitation of the independent claim 1 is that a transmission of at least one message comprising planning information (comprising information about the form of the user data message) must be made before a transmission of

the user data message. A further limitation of the independent claim 1 is that the form of the user data messages to be transmitted includes at least one of a data type of the user data messages and a coding of the user data messages. Basis for this amendment can be found throughout the whole application as filed, especially, paragraphs [0010] and [0026]. Thus, no new matter has been added. A marked-up version of the new set of claims is enclosed, from which the Examiner may take the individual amendments made.

The disclosure of the present invention provides an improved infrastructure that can be used by radio terminals to reduce their power consumption and by radio base stations to save air channels. The improved infrastructure comprises planning information which announces the form of user data messages to be transmitted. The form particularly comprises the data type and/or the coding of the user data messages. The terminal may use this improved infrastructure and decide to not receive the announced user data and, by doing so, save power. The reason for not receiving the announced user data might be that the terminal is not able to decipher the announced data type (e.g. because an appropriate editor is not available) or to decode the announced coding scheme (e.g. because the appropriate decoder is not installed). This infrastructure is particularly advantageous in radio communication systems with very limited resources on the air interface. Here the resources can be particularly saved in a multicast setup when the data are not sent by the radio base stations to all subscribed members of the multicast group but only to those which have decided that they are willing and able to receive the data.

Turning to *Lim*, multicasting and broadcasting methods are disclosed. Multicasting is sending identical data to a selected set of receiving parties. Broadcasting is sending identical data to a plurality of unspecified terminals. *Lim*, [0005]. With multicasting a receiving party has to subscribe in advance (e.g. dial into an audio- or videoconference) or is selected by a sending party (e.g. the email address of the receiving party being entered in the To: field of an email). *Lim*, [0005]. After subscription / selection the data are sent and received only by the members of the multicast group. If the data is sent to another party, then the terminal should refuse to receive the data. This can be achieved by transmission of so-called multi-cast identifiers which can be evaluated by the receiving terminals. If the terminal knows the identifier, then the data are received, otherwise not.

The problem addressed by *Lim*, is that in the prior art a multicast sender has set up a dedicated channel to each receiving party of the multicast group and this required a lot of recourses in the network due to multiple transmissions of identical data. *Lim* proposes to use one single common channel instead of multiple dedicated channels, hereby reducing the number of required channels. *Lim*, [0020]. The data can then either be multiplexed into this common channel or sent only once if possible. In order to selectively transmit the data to the member of the multicast group, header information is provided which is used to decide whether a specific subscriber is an intended recipient or not. *Lim*, [0021]. In detail the header comprises a multicast group identifier. *Lim*, [0048] and [0054]. The data is only received by those subscribers which have subscribed to the identified multicast group. *Lim*, [0051] and [0058]. However, *Lim* does not disclose an infrastructure where the form of user data messages to be transmitted is announced which renders, for the reasons given below, the subject matter of the independent claims **new**.

Lim does not disclose that the header information announces the types of the arriving packets. It is only disclosed that it is determined, based on header information within the packet data, whether the subscriber is an intended recipient of the packet data or not. *Lim*, [0021], [0022]. This is achieved with a header which comprises a **multicast group identifier**. *Lim*, [0048], [0054]. The data are only received by those subscribers which have subscribed to the identified multicast group. *Lim*, [0051], [0058]. Applicants have understood that the Examiner considers this multicast group identifier within the header to correspond to the planning information in the claimed invention.

A multicast group identifier is **neither a data type** of the packet data **nor a coding** of the packet data. With a multicast group identifier a subscriber's device can make a decision whether the subscriber is an intended recipient. However, it is **not possible** for a subscriber device to make, with a multicast group identifier, a decision whether it is capable of processing the user data message. This is only possible with planning information which includes at least one of a data type and a coding of the user data messages.

The transmission of the header information in *Lim* occurs together with the transmission of the user data messages, because the multicast or broadcast messages (data packets) are transmitted with the header information **within** the multicast or broadcast

messages (data packets). *Lim*, [0021], [0022]. Technically, the headers of the multicast or broadcast packet data in *Lim* must be sent together with the multicast or broadcast packet data, because otherwise the multicast or broadcast packet data could not be transmitted. However, the present independent claims require that the **transmission** of at least one message comprising planning information is made **before** the **transmission** of user data messages. Hereby the receiving terminal may use the planning information and decide to not receive the announced user data message and, by doing so, save power. This is not possible with the multicast or broadcast messages in *Lim*, because the transmission of the header information occurs **together** with the transmission of the user data messages.

The rejection under 35 U.S.C. §102 is respectfully traversed because of the clarified amended set of claims filed. Since *Lim* fails to disclose, at least, a method comprising announcing a form of the user data messages by transmission of at least one message comprising planning information **before transmission of the user data messages**, wherein the planning information comprises the form of the user data messages and wherein the form of the user data messages to be transmitted includes at least one of **a data type of the user data messages and a coding of the user data messages**, it is respectfully requested that the rejection under 35 U.S.C. §102 is withdrawn. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §102, if necessary.

Rejections under 35 U.S.C. §103

Claims 16-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Lim* in view of U.S. Patent No. 6,771,639 issued to Mark J. Holden ("Holden").

Claims 22, 24 and 26-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Lim* in view of well-known prior art.

Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on *ex post* reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

The rejection under 35 U.S.C. §103(a) is respectfully traversed because of the clarified amended set of claims filed. As explained above, *Lim* fails to teach or suggest, at least, a method comprising announcing a form of user data messages by transmission of at least one message comprising planning information before transmission of the user data messages, wherein the planning information comprises the form of the user data messages and wherein the form of the user data messages to be transmitted includes at least one of a data type of the user data messages and a coding of the user data messages.

The problem addressed by *Lim*, is that in the prior art a multicast sender has set up a dedicated channel to each receiving party of the multicast group and this required a lot of recourses in the network due to multiple transmissions of identical data. *Lim* proposes to use one single common channel instead of multiple dedicated channels, hereby reducing the number of required channels. *Lim*, [0020]. The data can then either be multiplexed into this common channel or sent only once if possible. In order to selectively transmit the data to the member of the multicast group, header information is provided which is used to decide whether a specific subscriber is an intended recipient or not. *Lim*, [0021]. In detail the

header comprises a multicast group identifier. *Lim*, [0048] and [0054]. The data is only received by those subscribers which have subscribed to the identified multicast group. *Lim*, [0051] and [0058]. However, *Lim* does not disclose an infrastructure where the form of user data messages to be transmitted is announced.

Without knowing the form of the data the terminal can make no decision whether it will be able to edit and/or decode the data. It might happen that a subscriber who has subscribed to a specific service (e.g. Video or Music Download or email push service) may receive data that is - according to the multicast technology - correctly sent to him as a subscribed member of a multicast group although the subscriber will not be able to edit and/or decode the received data. However, *Lim* gives no hint that this problem may occur nor does *Lim* give any hint to the subject matter of the independent claims which renders, for the reasons given below, the subject matter of the independent claims **non obvious**.

Lim does not disclose that the header information announces the types of the arriving packets. It is only disclosed that it is determined, based on header information within the packet data, whether the subscriber is an intended recipient of the packet data or not. *Lim*, [0021], [0022]. This is achieved with a header which comprises a **multicast group identifier**. *Lim*, [0048], [0054]. The data are only received by those subscribers which have subscribed to the identified multicast group. *Lim*, [0051], [0058]. Applicants have understood that the Examiner considers this multicast group identifier within the header to correspond to the planning information in the claimed invention.

A multicast group identifier is **neither a data type** of the packet data **nor a coding** of the packet data. With a multicast group identifier a subscriber's device can make a decision whether the subscriber is an intended recipient. However, it is **not possible** for a subscriber device to make, with a multicast group identifier, a decision whether it is capable of processing the user data message. This is only possible with planning information which includes at least one of a data type and a coding of the user data messages.

To emphasize this difference, claim 31 recites that subscriber devices can decide, on basis of the planning information, to receive only those user data messages it is capable of processing.

The transmission of the header information in *Lim* occurs together with the transmission of the user data messages, because the multicast or broadcast messages (data packets) are transmitted with the header information **within** the multicast or broadcast messages (data packets). *Lim*, [0021], [0022]. Technically, the headers of the multicast or broadcast packet data in *Lim* must be sent together with the multicast or broadcast packet data, because otherwise the multicast or broadcast packet data could not be transmitted. However, the present independent claims require that the **transmission** of at least one message comprising planning information is made **before** the **transmission** of user data messages. Hereby the receiving terminal may use the planning information and decide to not receive the announced user data message and, by doing so, save power. This is not possible with the multicast or broadcast messages in *Lim*, because the transmission of the header information occurs **together** with the transmission of the user data messages.

Turning to *Holden*, the availability of network resources and the power consumption of fixed terminals are not an issue, because *Holden* deals with fixed line networks. Thus *Holden* lies within another technical field and does not expressly deal with radio communication systems and subscriber devices of the radio communication system. Since *Holden* is silent about multicast and/or broadcast services, one having ordinary skill in the art would not be motivated to apply the teachings of *Holden* with the disclosure of *Lim*.

The subject matter as a whole would not have been obvious when combining *Lim* and *Holden*, and it is respectfully requested that the rejection under 35 U.S.C. §103(a) is withdrawn. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

Request for Continued Examination (RCE)

Applicants respectfully submit a Request for Continued Examination (RCE) Transmittal. The Commissioner is authorized to charge the fee of \$810.00 required to Deposit Account 50-2148 in order to effectuate this filing.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants respectfully submit a Petition for Two-Month Extension of Time. The Commissioner is authorized to charge the fee of \$490.00 required to Deposit Account 50-2148 in order to effectuate this filing.

Applicants believe there are no other fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2689.

Respectfully submitted,
BAKER BOTTs L.L.P.

Eric M. Grabski

Attorney for Applicants
Eric M. Grabski
Registration No. 51,749

Date: February 17, 2009

SEND CORRESPONDENCE TO:

BAKER BOTTs L.L.P.

CUSTOMER ACCOUNT NO. **31625**

512.322.2689

512.322.8383 (fax)